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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,242	01/21/2004	Kia Silverbrook	WAL04US	1572

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

COLILLA, DANIEL JAMES

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/760,242

Applicant(s)

SILVERBROOK ET AL.

Examiner

Daniel J. Colilla

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004 and 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-48 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/12/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "A Consumer Tote For a Roll of Wallpaper"

2. The disclosure is objected to because of the following informalities:

On page 42, line 7, it appears that "moldings 2000-2004" should actually be, --2002, 2004-- since these are the only two moldings shown in the figures.

Reference character "2022" has been used to in association with both the bearing surface (pgs. 42, lines 9-10) and the lid (pgs. 42, lines 15-17).

Appropriate correction is required.

Claim Objections

3. Claims 20-35, 39 and 43-47 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 19-34, 38 and 42-46 are drawn to a media cartridge. However, these claims do not further limit the structure of the media cartridge but instead recites structure of the environment in which applicant intends to use the media cartridge. Since no language further limiting the media cartridge these claims fail to further the parent claim 1.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 36-38, 40-42 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 36-38, 40-42 and 48, the statutory class of invention being claimed is unclear. The preambles begin by reciting "a consumer tote as claimed in claim 1" which would suggest that the claim is directed towards an apparatus. But then the claims continue with the phrase (or a similar phrase), "adapted for use in a method . . . comprising the steps of:" and the body of each respective claim recites a series of method steps. This would suggest that applicant is attempting to recite a method claim.

For purposes of prior art examination, these claims will be interpreted as apparatus claims.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

Art Unit: 2854

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 33 of copending Application No. 10/760,214. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 33 of SN 10/760,214 amongst other structure, includes all the structure recited in claim 1 of the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

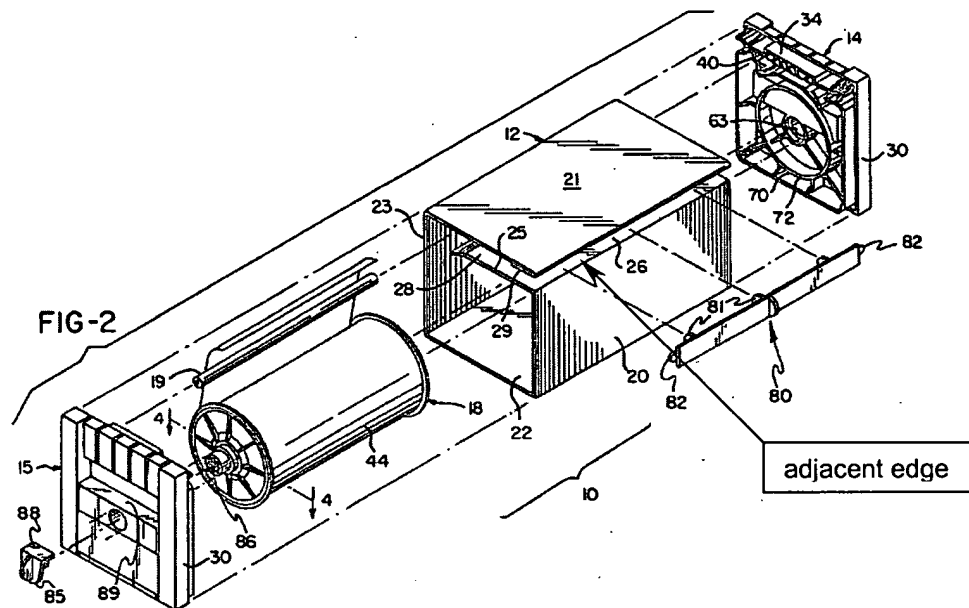
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4, 8, 18 and 20-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Beery (US 4,878,581).

With respect to claim 1, Beery discloses a tote that includes an exterior 12 with a main access flap 21, a pair of core access openings 63 and an interior with a core 50 which is aligned with the openings 63 as shown in Figures 7 and 8. It is noted that any object can be disposable if it is disposed of.

With respect to claim 2, Beery discloses a gap 26 between the access flap 21 and an adjacent edge as shown below from the Figure taken from Figure 2 of Beery:



With respect to claim 3, Beery discloses that the exterior 12 is made of a paperboard material (col. 3, lines 6-10).

With respect to claims 4 and 18, the core 50 is supported at each by a plastic hub 57 as shown in Figures 3-4 of Beery (col. 4, lines 1-7). It is noted that the term “molding” is a method of manufacture and holds no weight in an apparatus claim.

With respect to claims 20-35, 39 and 43-47, applicant has not recited any further structure of the consumer tote in these claims. Instead applicant has recited structure of other apparatus to be used with the consumer tote. Since the consumer tote has not been further limited in these claims, they are rejected along with their parent claim, claim 1.

Art Unit: 2854

With respect to claims 36-38, 40-42 and 48, these claims only further limit the claim by reciting a process of how the tote is to be used. Since this is an apparatus claim the method of how the tote is to be used holds no patentable weight. Therefore, these claims are rejected along with their parent claim, claim 1.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5-7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beery (US 4,878,581) in view of Sirianni (US 5,413,220).

With respect to claims 5-6 and 19, Beery discloses the claimed consumer tote except for each hub being surrounded by a bearing surface which locates the hub in a respective access opening. However, Sirianni teaches a supporting hub for a core C which has a surface that surrounds the hub and bears on the bottom of the interior of box B as shown in Figure 8 of Sirianni. In combination with Beery the bearing surface taught by Sirianni would provide the support that locates the hubs in the access openings disclosed by Beery. It would have been obvious to combine the teaching of Sirianni with the consumer tote disclosed by Beery for the advantage of the energy attenuating support which protects the roll in the box from damage due to shock (Sirianni, col. 1, lines 6-12).

With respect to claim 7, the bearing surface taught by Sirianni is circular and is connected to the hub by spokes 44 as shown in Figure 2 of Sirianni.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beery (US 4,878,581) in view of Badum (US 3,627,225).

Beery discloses the claimed tote except for the external coupling for engaging a rotating winding spindle. However, Badum discloses a tote 10 with an external coupling 58 which provides an external driving interface which can be driven by a spindle. It would have been obvious to combine the teaching of Beery with the tote disclosed by Beery for the advantage of winding and unwinding the contents of the tote without having to remove it from the tote.

13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beery (US 4,878,581) in view of Badum (US 3,627,225), as applied to claim 8 above, and further in view of Kofler (US 4,697,756).

Beery in view of Badum discloses the claimed tote except for the ring of teeth on the external coupling. However, Kofler discloses a coupling 26a for driving a hub that includes a ring of teeth as shown in Figure 1 of Kofler. It would have been obvious to combine the teaching of Kofler with the tote disclosed by Beery in view of Badum for the advantage of providing a positive mechanical engagement in the coupling that prevents slipping of the coupling.

14. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beery (US 4,878,581) in view of Jamet (EP 826618).

Art Unit: 2854

With respect to claim 10, Beery discloses the claimed tote except for the handle. However, Jamet discloses a tote 4 with a handle 11,11 that folds flat against the exterior of the tote as shown in Figure 1 of Jamet and disclosed in the English abstract. It would have been obvious to combine the teaching of Jamet with the tote disclosed by Beery for the advantage of a convenient handle for carrying the tote.

With respect to claim 11, the handle is formed by two similar sub-units 11 which fold from a flat position adjacent the sides of the tote to a cooperating position in which a handle opening in each sub-unit 11 to form a grip as shown in Figure 1 of Jamet.

15. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beery (US 4,878,581) in view of Badum (US 3,627,225), as applied to claim 8 above, and further in view of Cocchi et al. (US 5,450,949).

Beery in view of Badum discloses the claimed tote except for the visible marker. However, Cocchi et al. teaches a roll of media that has a label 6 with a visible indicator 8 indicating proper placement of the reel relative to unwinding means. It would have been obvious to combine the teaching of Cocchi et al. with the tote disclosed by Beery in view of Badum for the advantage of indicating to the user the proper orientation of the tote relative to an unwinding means. Furthermore, such a visible indicator is a basic instructional expedient that would have been obvious to one of ordinary skill in the art.

16. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beery (US 4,878,581).

Art Unit: 2854

With respect to claim 14, Beery discloses the claimed tote except that no specific dimension is disclosed. However, the dimensioning of a product to fit another apparatus would have been an obvious modification that could have readily been determined through routine experimentation by one of ordinary skill in the art. Additionally, it has been established that when the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (see MPEP 2144.04, section IV, part A).

With respect to claim 16, while it is not known to the examiner if the tote disclosed by Beery can hold 50 meters of wallpaper, if it cannot, then it is simply a matter of making the tote larger. Changes in dimension of the tote have been addressed above with respect to claim 14.

17. Claims 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beery (US 4,878,581) in view of Takayama (EP 826618).

Beery discloses the claimed tote except for the viewing window. However, Takayama discloses a tote 1 for containing a roll of media including a window (not shown) in the side sheet 4 or the lid 7 (Takayama, col. 9, lines 28-30). It would have been obvious to combine the teaching of Takayama with the tote disclosed by Beery for the advantage of being able to view the inside of the tote to determine what type of media is inside or how much media is remaining.

18. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beery (US 4,878,581) in view of Moggia (EP 327712).

Art Unit: 2854

Beery discloses the claimed tote except for the adjacent edge of the exterior that includes a return lip. However, Moggia discloses an exterior edge, adjacent the gap, that includes a return lip 9 as shown below in Figures 1 and 4 of Moggia. It would have been obvious to combine the teaching of Moggia with the tote disclosed by Beery for the advantage of using the cover 2 and the cooperating rim 9 together to press the paper down allowing a user to tear of a portion of the dispensed paper.

Allowable Subject Matter

19. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

20. The following is a statement of reasons for the indication of allowable subject matter:

Claim 12 has been indicated as containing allowable subject matter primarily for each sub-unit having an edge affixed to the exterior adjacent to the gap.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (571) 272-2157. The examiner can normally be reached Mon.-Thur. between 7:30 am and 5:00 pm. Faxes regarding this application can be sent to (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (571) 272-2168. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 2854

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 23, 2005



Daniel J. Colilla
Primary Examiner
Art Unit 2854